

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

MAILED

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PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID R. PAYNE, GERALD A. STANGL,
NORMAN E. STEVENS JR., and MICHAEL F. GARD

Application No. 10/617,975

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was electronically received at the Board of Patent Appeals and Interferences on February 9, 2006. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the examiner. The matters requiring attention prior to docketing are identified below.

On April 27, 2004, appellants filed an Information Disclosure Statement (IDS). It is not clear from the record whether the examiner fully considered the IDS submitted (i.e., "Floyd Ray Gunsaulis, P.E.") or whether the examiner notified appellants of why the submission did not meet the criteria set forth in 37 CFR §§ 1.97 and 1.98.

In addition, a review of the file indicates that the appeal brief filed June 21, 2005 is in the format set forth in 37 CFR § 1.192(c). However, 37 CFR § 1.192 was abolished on September 13, 2004, and replaced by 37 CFR § 41.37(c). Accordingly, the appeal brief filed on June 21, 2005 does not comply with 37 CFR § 41.37(c).

37 CFR § 41.37(c) states:

(c)(1) The brief shall contain the following items under appropriate headings and in the order indicated in paragraphs (c)(1)(I) through (c)(1)(x) of this section, except that a brief filed by an appellant who is not represented by a registered practitioner need only substantially comply with paragraphs (c)(1)(I) through (c)(1)(iv) and (c)(1)(vii) through (c)(1)(x) of this section:

(v) *Summary of claimed subject matter.* A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawing, if any, by reference characters. For each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of paragraph (c)(1)(vii) of this section, every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.

(vi) *Grounds of rejection to be reviewed on appeal.* A concise statement of each ground of rejection presented for review.

(vii) *Argument*. Each ground of rejection must be treated under a separate heading. For each ground of rejection applying to two or more claims, the claims may be argued separately or as a group.

(ix) *Evidence appendix*. An appendix containing copies of any evidence submitted pursuant to §§ 1.130, 1.131, or 1.132 of this title or of any other evidence entered by the examiner and relied upon by appellant in the appeal, along with a statement setting forth where in the record that evidence was entered in the record by the examiner. Reference to unentered evidence is not permitted in the brief. See § 41.33 for treatment of evidence submitted after appeal. This appendix may also include copies of the evidence relied upon by the examiner as to grounds of rejection to be reviewed on appeal.

(x) *Related proceedings appendix*. An appendix containing copies of decisions rendered by a court or the Board in any proceeding identified pursuant to paragraph (c)(1)(ii) of this section.

The Grouping of Claims section is no longer required. Also, the following appropriate sections are missing from the appeal brief:

1) "Summary of claimed subject matter" as set forth in 37 CFR § 41.37(c)(1)(v);

2) "Grounds of rejection to be reviewed on appeal" as set forth in 37 CFR § 41.37(c)(1)(vi);

3) "Evidence appendix" as set forth in 37 CFR § 41.37(c)(1)(ix); and

4) "Related proceedings appendix" as set forth in 37 CFR § 41.37(c)(1)(x).

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A substitute appeal brief that is in compliance with 37 CFR § 41.37 are required. For more information on the Board's new rules see the web page entitled More Information on the Rules of Practice Before the BPAI, Final Rule at:

<http://www.uspto.gov/web/offices/dcom/bpai/fr2004/moreinfo.html>.

Furthermore, the examiner's answer mailed on September 8, 2005 does not comply with the headings as set forth in the new rules under 37 CFR § 41.37(c). Correction is required.

Accordingly, it is


ORDERED that this application be returned to the examiner to: 1) consideration of the Information Disclosure Statement filed April 27, 2004; 2) appropriate written notification by the examiner to appellants of such consideration 3) hold the appeal brief of June 21, 2005 defective; 4) request appellants to file a substitute appeal brief in compliance with 37 CFR § 41.37; 5) consider the substitute appeal brief; 6) vacate the examiner's answer and provide a revised examiner's answer in accordance with the new rules effective September 13,

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2004 and in response to the substituted appeal brief; and 7) for such further action as may be appropriate.

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